

## REMARKS/ARGUMENTS

The Applicants hereby thank the Examiner for the observations in the outstanding Office Action. Claims 4-7 and 9-11 are herein amended to better encompass the full scope and breadth of the present invention, notwithstanding the Applicants' belief that the claims would have been allowable as originally filed. Accordingly, the Applicants respectfully assert that no claims have been narrowed within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* (Fed.Cir. November 29, 2000). Therefore, reconsideration of the present application in light of the foregoing amendment and these remarks is respectfully requested.

### **I. Objection to Claims 4-7, 9, and 10 on the Grounds of Informalities.**

Claims 4-7, 9, and 10 have been objected on the grounds of informalities. Claim 4 has been objected on the ground that the term "body" (l. 14) should be amended to the term "appendage;" and Claim 4 is herein amended accordingly. Claims 5-7 and 9 have been objected on the ground that the term "system" should be inserted before the term "novelty" (l. 1); and Claims 5-7 and 9 are herein amended accordingly. Claim 9 has been further objected on the ground that the phrase "one or more" should be inserted before the term "appendages" (l. 2); and Claim 9 is herein further amended accordingly. Claim 10 has been objected on the ground that the term "having" (l. 7) should be amended to the term "comprising;" and Claim 10 is herein amended accordingly. Claim 9 is also herein further amended to depend from Claim 7.

Thus, the Applicants believe that herein amended Claims 4-7, 9, and 10 overcome these grounds for objection on this basis. Therefore, the Applicants respectfully request that these grounds for objection on this basis be withdrawn.

**II. Rejection under 35 U.S.C. § 112, second paragraph, of Claims 6, 7, 10, and 11.**

Claims 6, 7, 10, and 11 have been rejected, under 35 U.S.C. § 112, second paragraph, on the grounds that, in Claim 6, the phrase "configured to connect to said one or more appendages" (ll. 2-3) renders unclear the configuration of the connecting structure which is required to allow the connecting structure to connect to the one or more appendages, that, in Claim 7, the phrase "configured to secure to said second end of said connecting structure" (ll. 2-3) renders unclear the configuration of the enclosure which is required to allow the enclosure to allow its securing to the second end of the connecting structure, that, in Claim 10, the phrase "configured for connection of said appendages to said body" (l. 8) renders unclear the configuration of the connecting structures required for allowing the connecting structures to connect the appendages to the body, that, also in Claim 10, the phrase "positioning thereby a plurality of prongs flexibly coupled to a first end of each said connecting structures" (ll. 15-16) renders unclear its limitation on the kit, and that, in Claim 11, the phrase "connecting structures are inserted into said apertures" (ll. 2-3) renders unclear its limitation on the kit. The Applicant hereby respectfully traverses these grounds for rejection on this basis.

However, to better encompass the present invention, the following amendments have been made. Claim 6 is herein amended by deleting the phrase "configured to connect" and instead inserting the phrase "for facilitating its connection." Claim 7 is herein amended by deleting the phrase "configured to secure" and instead inserting the phrase "for facilitating its securing." Claim 10 is herein amended by deleting the term "configured" before the word "for" and inserting the term "facilitating" after the word "for" as well as by deleting the term "secured" and instead inserting the term "securable," by deleting the phrase "positioning thereby" and instead inserting the phrase "each said connecting structure comprising." Claim 11 is herein amended by deleting the term "inserted" and instead inserting the term "insertable."

Thus, the Applicants believe that herein amended Claims 6, 7, 10, and 11 overcome these grounds for rejection on this basis. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn.

**III. Rejection of Claims 4 and 9 under 35 U.S.C. § 102(b) on the Ground of Higdon (US 5375363).**

Claims 4 and 9 have been rejected, under 35 U.S.C. § 102(b), as being anticipated by Higdon (US 5375363). The Examiner asserts that, with respect to Claim 4, Higdon teaches a connecting structure 354 having a flexible connecting member 30 comprising a coil spring and a post A2 with prongs 364 and that, with respect to Claim 9, Higdon teaches the connecting member 30 having a spring constant that allows the head to be freely movable with respect to the body. The Applicants hereby respectfully traverse these grounds for rejection on this basis.

Higdon merely teaches a decoy having a movable neck, the decoy comprising a neck-to-body connector 354 having a pair of flexible ears 364 projecting therefrom and for inserting into a hole 366 of the body 312 (col. 3, l. 67 – col. 4, l. 6). Referring to Figures 3 and 10, Higdon discloses *only two ears* 364 which subtend an *obtuse angle* with the ring structure A2. Further, the term “ears” and the ring structure A2 are low aspect ratio elements by their definition and as shown and described throughout the Specification and drawings of Higdon.

However, to better encompass the present invention, the following amendments have been made. Claim 4 is herein amended by inserting the language “and the plurality of *prongs extending away from said post and toward said second end*” from withdrawn Claim 1. This being so, the plurality of prongs 27, i.e., *at least two prongs*, subtend an *acute angle* with the post 12. Since the prongs 27 are coupled to the first end of the post 12 and extend away from the post 12 and toward the second end of the post 12, the prongs 27 inherently and necessarily subtend an acute angle with the post 12. In addition, the present invention recites the elements “post” and “prongs,” wherein both terms, by definition, imply an aspect ratio of greater than one, i.e., a higher aspect ratio. As such, the present invention, comprising an acute angular orientation of the high aspect ratio elements, i.e., the prongs 27 in relation to the post 12, is distinct from Higdon, disclosing an *obtuse* angular orientation of the low aspect ratio elements, i.e., the ears 364 in relation to the ring structure A2.

Thus, the Applicants respectfully submit that Higdon does not teach the limitations of herein amended Claim 4 or those of Claim 9, by dependency. Herein amended Claims 4 and 9 are believed to overcome these grounds for rejection on this basis. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn and that Claims 4 and 9 be passed to allowance.

**IV. Rejection of Claims 5-7 under 35 U.S.C. § 103(a) on the Ground of Higdon (US 5375363), in view of Weiser et al. (US 6599160), and Rejection of Claims 10 and 11 on the Ground of Weiser et al. (US 6599160), in view of Higdon (US 5375363).**

Claims 5-7 have been rejected, under 35 U.S.C. § 103(a), as being unpatentable over Higdon (US 5375363), in view of Weiser et al. (US 6599160); and Claims 10 and 11 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Weiser et al. (US 6599160), in view of Higdon (US 5375363). The Examiner concedes that Higdon does not teach that the appendage can be a wing structure, but relies on Weiser for the teaching. The Applicants hereby respectfully traverse these grounds for rejection on this basis.

As discussed, supra, in light of herein amended independent Claim 4, the present invention, comprising an acute angular orientation of the high aspect ratio elements, i.e., the prongs 27 in relation to the post 12, is believed to be distinct from Higdon, disclosing an obtuse angular orientation of the low aspect ratio elements, i.e., the ears 364 in relation to the ring structure A2. Claims 5-7 subsume the limitations of Claim 4 by dependency.

However, to better encompass the present invention, the following amendments have been made. Claim 5 is herein amended to recite: "The novelty system of Claim 4, wherein said one or more appendages comprises a wing structure." Claim 6 is herein amended to recite: "The novelty system of Claim 5, wherein said connecting structure includes a second end for facilitating its connection to said one or more appendages." Claim 7 is herein amended to recite: "The novelty system of Claim 6, wherein said one or more appendages comprise an enclosure for facilitating its securing to said second end of said connecting structure."

Claim 10 is herein amended to recite: "A kit for constructing a novelty comprising: a plurality of detached novelty portions combinable for shipping said novelty in at least a partially unassembled form, said novelty portions comprising a body with apertures for receiving connecting structures, one or more appendages including at least one flexible connecting member comprising a coil spring extending therefrom, and connecting structures for facilitating connection of said appendages to said body by connecting one end of said flexible connecting member to said connecting structure and connecting another end to said body, said one or more appendages being securable upon assembly of said novelty to project in a displaceably suspended manner from said body by operatively connecting said connecting structures with said apertures of said body, each said connecting structure comprising a plurality of prongs flexibly coupled to a first end of each said connecting structure to extend towards said body, and said prongs terminating at respective termini for engaging said body." Claim 11 is herein amended to recite: "The kit of Claim 10, wherein said connecting structures are insertable into said apertures."

With respect to the secondary cited reference, Weiser et al. (US 6599160), the Applicants respectfully submit that this reference should be disqualified as prior art under 35 U.S.C. § 103(c)(1) which provides:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time of the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In addition, 35 U.S.C. § 102(e)(2) provides:

a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, ....

Applying § 103(c)(1) and 102(e)(2) to the facts of the instant application, the subject matter of the cited reference, Weiser et al. (US 6599160), corresponds to five inventors, Isaac Weiser, Margaret Weiser, Yong-Biao Ye, Xiao-Hong Guo, and Jin-Mao Huang, while the subject matter of the present application corresponds to two inventors, Isaac Weiser and Margaret Weiser. As such, the subject matter of the present application has been developed by "another person."

Further, the cited reference is a patent, i.e., Weiser et al. (US 6599160), granted on an application for patent by another, i.e., the set of five inventors, filed in the United States before, i.e., the filing date of US 6599160, June 6, 2002, precedes the filing date, July 1, 2003, of the present application by the applicant for patent, i.e., the two inventors. As such, the cited reference would otherwise, and only in the hypothetically, qualify as prior art under subsection (e) of section 102.

Also, the subject matter of the cited reference Weiser et al. (US 6599160) and the claimed invention were, at the time of the claimed invention was made, assigned to owned by the same person, i.e., the entity Exhart Environmental Systems, Inc., as evident on the face of the patent. The present application has also been assigned to the Entity Exhart Environmental Systems, Inc., as evident from the record, i.e., Notice of Recordation of Assignment Document, Reel/Frame No. 014278/0039. Consequently, the Applicants respectfully request that Weiser et al. (US 6599160) be disqualified as a § 103(a) reference under 35 U.S.C. § 103(c). In light of Weiser being disqualified as a reference, Higdon alone does not teach, motivate, nor suggest the invention of Claims 5-7, 10, and 11.

Thus, the Applicants respectfully submit that Higdon, even in view of Weiser does not teach, motivate, nor suggest the limitations of herein amended Claims 5-7 and that Weiser, even in view of Higdon does not teach, motivate, nor suggest the limitations of herein amended Claims 10 and 11. Herein amended Claims 5-7, 10, and 11 are believed to overcome these grounds for rejection on this basis. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn and that Claims 5-7, 10, and 11 be passed to allowance.

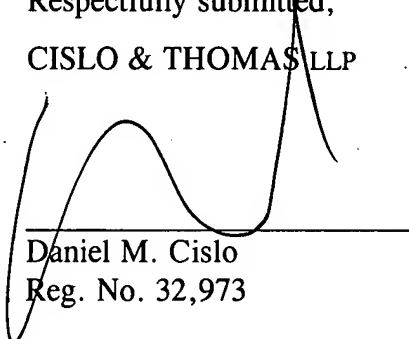
CONCLUSION

Accordingly, Claims 4-7 and 9-11 are herein amended to better encompass the full scope and breadth of the present invention, notwithstanding the Applicants' belief that the claims would have been allowable as originally filed. The Applicants respectfully reassert that no claims have been narrowed within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* (Fed.Cir. November 29, 2000). Therefore, reconsideration of the present application in light of the foregoing amendment and these remarks is respectfully requested. The Examiner is further cordially invited to telephone the undersigned for any reason which would advance pending claims to allowance.

Respectfully submitted,  
CISLO & THOMAS LLP

Date: \_\_\_\_\_

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